

## **REMARKS**

The Office Action has been carefully considered. Claims 30-35 are pending in the present application. Reconsideration of the present application in view of the following remarks is respectfully requested.

### **I. REJECTION OF CLAIMS 30-35**

Claims 30-35 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over United States Patent No. 6,096,070 to Ragheb *et al.* (“Ragheb”) in view of United States Patent No. 6,379,379 to Wang (“Wang”). This rejection is respectfully traversed.

Independent claim 30 recites a medical device having a coated tube-like portion comprising at least one laser-ablated opening extending through the coated portion. The opening is formed by ablating a coated structure with a laser. Claims 31-35 depend from claim 30 and, thus, also include the recitations of claim 30.

As discussed in the Amendment dated March 17, 2005, Ragheb does not disclose or suggest a laser-ablated opening extending through the coated portion of the medical device as recited in the present claims. In contrast, as shown in Figs. 1D, 2D and 2E in the present specification, in the presently claimed invention the ablated opening extends through the ablated structure. At most, Ragheb teaches a medical device that has a base material where holes, wells, slots, grooves and the like are formed in the surface of the device by utilizing lasers (col. 16, lines 58-63). When such apertures are formed in Ragheb, they do not extend through the ablated base material as shown in Fig. 10A-D of Ragheb. Rather, Ragheb teaches that the apertures are used for containing bioactive material (col. 16, lines 36-38). In order for the apertures to contain the bioactive material, the apertures do not extend through the base material (Fig. 10A-D). Accordingly, Ragheb teaches away from openings that extend through a coated portion of a medical device.

Although Ragheb teaches the use of lasers for cutting the surface of the device (col. 16, line 58-63), Ragheb does not disclose or suggest ablating a coated structure with a laser to form at least one opening extending through the coated portion as presently claimed.

According to MPEP § 2113, “[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where . . . the manufacturing process steps would be expected to impart

distinctive structural characteristics to the final product.” As stated in the present specification, the “polymer coating, when applied by methods in the art, tends to create bridges at small gaps or corners between stent struts. Also, in the conventional methods, wherein a coating process takes place after a shaping process, it is almost impossible to selectively coat the stent. For example, it is impossible to coat one side of a stent without coating the other side or to apply different coatings to the outside and inside of a stent.” Present specification, page 1, line 32, to page 2, line 1. In contrast, “medical devices having multiple coating layers and a complicated geometry pattern can also be easily manufactured by the method of the present invention without flaws such as polymer-bridges at gaps or corners.” Present specification, page 9, lines 21-23. Thus, the resultant medical device of Ragheb would not be the same as that presently claimed.

Accordingly, Ragheb does not teach or suggest a medical device made by a process wherein a coating material and the structure covered by such material are ablated together by a laser as in the presently claimed invention.

Wang does not remedy the deficiencies of Ragheb because Wang cannot be applied as a basis for an obviousness rejection. Pursuant to 35 U.S.C. §103(c) and M.P.E.P. § 706(l), a reference, which qualifies as prior art only under one or more of subsection 35 U.S.C. § 102 (e), (f), and (g), does not qualify as a prior art reference against an application if (1) such application was filed on or after November 29, 1999, and (2) the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Wang issued on April 30, 2002. The present application was filed on December 3, 2001, and the parent application of the present application, U.S. Patent Application No. 09/724,503, was filed on November 28, 2000. Since Wang did not issue until after the present application was filed, Wang can only qualify as prior art under 35 U.S.C. § 102(e). In addition, the present application was filed after November 29, 1999. Also, at the time the present invention was made, the inventor of Wang and the inventor of the present application were subject to an obligation to assign their respective inventions to Scimed Life Systems, Inc. Pursuant to this obligation, Wang and the present application were, at the time the invention of the present application was made, owned by Scimed Life Systems, Inc. An Assignment from the inventors of the invention in Wang to Scimed Life Systems, Inc. was recorded in the U.S. Patent and Trademark Office ("USPTO") on May 5, 1998, at Reel 9160, Frame 0032, and an Assignment from the inventor of the present invention to

Scimed Life Systems, Inc. was recorded in the USPTO on November 22, 2000, at Reel 011724, Frame 0526. Thus, Wang does not qualify as prior art that can be used in a 35 U.S.C. § 103(a) rejection.

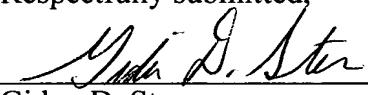
Accordingly, withdrawal of this rejection and allowance of claims 30 - 35 are respectfully requested.

## II. CONCLUSION

As the claim rejection has been overcome, all pending claims are believed to be in condition for allowance. Should the Examiner not agree with Applicant's position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the allowance of the application.

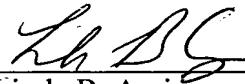
Respectfully submitted,

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